

REMARKS/ARGUMENTS

Claims 1, 4-7, 16 and 20 were rejected under 35 U.S.C. 102 (b) as being anticipated by Bechtel et al, U.S. patent 5, 371,991 ('991). Claims 2-3, 8, and 17-19 were rejected under 35 U.S.C. 103(a) as being obvious over Bechtel in view of Schumacher et al, U.S. Patent 4,121,798. Claim 1 is cancelled. Claim 21 is presented. Claims 2-8 are amended to depend from Claim 21. Claims 9-15 stand withdrawn without prejudice to Applicant's rights with respect to further prosecution of those claims. Claim 16 is amended. The claims as amended and presented are believed to distinguish structurally from the art of record and to be unobvious over the art, whether the art is considered singly or in combination.

Applicant has devised an extremely successful device used to quickly and efficiently set up and/or remove, in conjunction with what are commonly known as retail displays or display towers, attention attracting items in the form of small signs or panels often used by department stores and similar merchants to attract the attention of their customers to a particular display of goods. In one form, the invention comprises an elongated clip with a unitary body having an intermediate section and a first pair of opposed arms, the body having an interior surface and an interior surface arranged to define an elongated open mouth axially extending channel and a second pair of opposed arms formed along the external surface proximate one of the arms of the first pair of opposed arms. The claims have been amended to more specifically require that

the channel mounts to the display while the second pair of opposed arms receive at least a portion of the display panel.

None of the art of record discloses similar structure or gives a similar result. Bechtel '991, relied upon by the Examiner in the context of the original claims, discloses a re-bar clamp for use in forming concrete footings that require the reinforcing steel rods to be spaced upwardly at a predetermined height above ground so that when the concrete is poured into the footings, the reinforcing bars will be completely encapsulated by the concrete. It is respectfully suggested that it is only with the hindsight knowledge provided by Applicant's disclosure that one skilled in the art would even consider the '991 patent for any purpose related to Applicant's invention, and even with that hindsight, the '991 structure will not function for Applicant's purpose without substantial modification. But that need modification only is provided by Applicant's disclosure, and not by the art of record.

The M.P.E.P. provides at §2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in ... claim." *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Because there is no suggestion in the '991 patent to provide a clip a first set of opposed arms which in part define an axially extending channel for receiving at least a

portion of a merchandise display, either along or in conjunction with a second pair of opposed arms located proximate to one of the arms of the first part, the second pair of opposed arms receiving a portion of a display panel as required by the claims, reconsideration and withdrawal of the rejection under 35 USC 102 are respectfully requested.

It is respectfully suggested that the claim rejections based on 35 U.S.C. 103 are also without merit. Schumacher, 4,121,798 was relied upon by the Examiner, again in the context of the original claims, to show an outward flare at the ends of each of the pair of arms. However, all of the claims, as amended and presented, require more. For example, as indicated above the claims all require an elongated open mouth channel defined by an intermediate section and a first pair of opposed arms for receiving at least a portion of a merchandise display, and a second pair of opposed arms located proximate of one of the arms of the first pair of opposed arms for receiving at least a portion of a display panel. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure." MPEP § 2143.

Further, "a statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP §2143.01(IV) (emphasis in original).

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." MPEP §2143.01(I) (Citations omitted)

The recent KSR case (KSR Int'l. Co. v. Teleflex, Inc. No 04-1350 (U.S. Apr. 30, 2007) is not believed to have altered the requirements. See U.S.P.O MEMORANDUM attached as Exhibit 1.

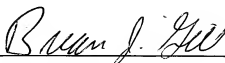
The art indicated as pertinent to Applicant's disclosure and not relied upon by the Examiner is noted as art of interest.

For the reasons that the claims as amended and presented are believed to distinguish structurally from the art of record, whether that art is considered singly or in

Application No. 10/802,640
Amendment dated July 18, 2007
Reply to Office action of July 10, 2007

combination, entrance of the amendment, reexamination of claims, and passage of the case to issue are respectfully requested.

July 18, 2007

A handwritten signature in cursive script, reading "Brian J. Gill", is written over a horizontal line.

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MEMORANDUM

DATE: May 3, 2007

TO: Technology Center Directors

FROM: Margaret A. Focarino
Margaret A. Focarino
Deputy Commissioner
for Patent Operations

SUBJECT: Supreme Court decision on *KSR Int'l Co., v. Teleflex, Inc.*

The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourtus.gov/opinions/06pdf/04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

- (1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:
- (a) determining the scope and contents of the prior art;
 - (b) ascertaining the differences between the prior art and the claims in issue;
 - (c) resolving the level of ordinary skill in the pertinent art; and
 - (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

(2) The Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

(3) The Court rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.



(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. The Court specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.